DECLARATION TO DISQUALIFY REFERENCE UNDER 37 C.F.R. 1.130(a)

Pursuant to MPEP Sec. 706.02(1)(2), on behalf of the applicants, the undersigned hereby declares that the present application (Ser. No. 09/843,972) and U.S. Paten No. 5,970,030 were, at the time the invention of Ser. No. 09/843,972 was made, and currently still are, commonly owned by International Business Machines Corporation.

A terminal disclaimer is attached pursuant to Rule 130 (a)(1).

REMARKS

The examiner objected to figure 5 by indicating that only that
which is old is illustrated and, therefore, the figure should be
designated with a legend such as Prior Art. This would be true
if figure 5 depicts only a common floppy disk. However, figure 5
is an illustration of an article of manufacture 100 which
embodies one or more programs of executable computer
instructions for causing the controller 18 to perform steps
according to the present invention (p. 12, lines 12-14). As
such, the figure illustrates more than that which is old.
Accordingly, the applicant respectfully requests that the
examiner reconsider the objection to figure 5.

Claims 1-19 are pending and stand rejected. The examiner
rejected claims 1-19 under the doctrine of obviousness-type
double patenting as being upatentable over claim 1, 7, 9 and 12
of U.S. Patent No. 6,754,768. Accordingly, a terminal disclaimer
in compliance with 37 CFR 1.321(c) is attached to this
communication.

The examiner also rejected claims 1-13 under 35 U.S.C. 103(a) as
being unpatentable over Sun [Sun StorEdge™ SCSI Target emulation
(STE) 1.1 Release Notes] in view of Dimitri [US 5,970,030].
However, the inventions defined by the claims in the instant
application an by the claims in the Dimitri patent are owned by

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the same party. Accordingly, the applicant wishes to disqualify the Dimitri patent as prior art under 37 CFR 1.130 (a) and attaches a terminal disclaimer in compliance with 37 CFR 1.321(c) and a declaration in compliance with MPEP Sec. 706.02 (1)(2).

Claims 1-12 have been canceled without prejudice and have been substantially rewritten as claims 20-30 to more accurately claim the subject matter of the invention, as described in the specification. Claim 13 has been canceled without prejudice. In addition to the disqualification of the Dimitri patent, the applicant contends that the indicated obviousness rejection can be overcome by the following arguments.

Sun discloses connecting a host computing device to a storage server and accessing attached storage as if it were one or more SCSI target devices (p. 3, paragraph 1). The Sun device consists of target emulation software and Fibre Channel Host Adapter Boards that allow multiple LUNs to be configured on a single Fibre Channel port (p. 3, paragraph 2) and a cache for receiving SCSI commands (p. 5). The cache issues input/output requests to the physical devices in the attached storage only as needed. Dimitri discloses fetching physical devices in attached storage and coupling it to a communication port (col. 2, lines 57-63; col. 3, line 55 to col. 4, line 7).

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The motivation to combine the two references, as stated by the examiner, is that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Sun with those of Dimitri, because doing so would "... provide a low cost means for switching library controllers between accessors", and would also "... provide a low cost automation of the failed recording device or failed drive replacement process." (Dimitri, especially: col. 2, lines 24-30). However, neither Sun or Dimitri address the unique problems associated with using Fibre Channel protocols and, as such, fail to provide a motivation for modifying the teaching of Sun with those of Dimitri. Accordingly, the applicant respectfully argues that the instant application is not obvious and unpatentable over Sun in view of Dimitri.

The fibre channel protocol employs two kinds of ports. "N" ports are coupled to peripheral devices with which a computer communicates, and so-called "fabric" ports are switches within a network of switches that is termed a fabric. The fiber channel protocol presumes communication through switches and N ports and, therefore, presumes direct communication with the peripheral devices (p. 1, line 18 through p. 2, line 7).

A problem arises whenever the fibre channel protocol is to be used for communicating with N ports to which no devices are currently connected. This situation occurs, for example, in a

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library of computer memory elements wherein shelved storage
elements must typically be brought to an input/output station
for connection to a port some time after the address identifying
the storage element is received (p. 2, lines 7-12).

As noted, the fiber channel protocol utilizes two types of ports
with a presumed direct connection to peripheral devices.
However, neither Sun nor Dimitri explores accommodating this
unique requirement of the fiber channel protocol. In fact, the
hierarchical nature of the fiber channel protocol itself would
lead one of ordinary skill in the art to avoid using the device
disclosed by Dimitri and to utilize well-known and economical
solutions such switches, routers, and bridges as obvious
extensions of the fiber channel protocol.

Because the fiber channel protocol presumes a direct connection
to a targeted peripheral device, the mechanical movement of the
picker disclosed by Dimitri causes a delay that prevents a host
computer from addressing the peripheral device as intended
without additional action. Two potential solutions are presented
in the instant application, namely, (a) instructing the host
computer to hold off any read or write operations until the
peripheral device is ready (p. 6, lines 9-11, new claims 22,
27), and (b) cache data if the host computer is attempting to
write and retrieving data from the cache if the computer is
attempting to read (p. 6, lines 11-14, new claims 23, 28, and

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30). In contrast, neither Sun nor Dimitri teach delaying a read/write operation until the peripheral device is ready.

Therefore, the device described by Sun, in view of Dimitri, is believed to teach away from the present invention. As such, the applicant respectfully submits that new claims 20-30 are not obvious over Sun in view of Dimitri and are therefore patentable.

In view of the foregoing and the terminal disclaimer attached hereto, the applicant believes that Claims 14-30 recite allowable subject matter. Accordingly, the applicant respectfully requests reconsideration of the rejection. The applicant and his attorney thank the Examiner for the thorough examination of the application.

Please charge the $260 fee for the attached terminal disclaimers, as well as any other charge incurred with this response, to our Deposit Account No. 17-0055.

Respectfully submitted,

Les A. Boegemann
Reg. No. 50,121

(520) 770-8714 phone
(520) 770-2224 fax

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